

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

Claims 1-26 stand provisionally rejected for double patenting;
Claims 1-10, 17-18, 22-26 stand rejected under 35 USC § 102; and
Claims 11-16 and 19-21 stand rejected under 35 USC § 103;

Claim Amendments

The claims, except for claim 3, are maintained without amendment. Claim 3 is amended merely to improve syntax.

Double Patenting

The provisional double patenting rejection is again traversed.

First – it is irrelevant that the same subject matter is “disclosed” in USN 09/925,649. What is relevant is whether the claimed subject matter is the same in the two applications.

Second – the argument that there is no apparent reason why the applicant would be prevented from presenting claims corresponding to those of the instant application in the USN 09/925,649 is without merit. What may potentially be done is irrelevant until it comes into existence and a factual claim situation is realized.

Third – the independent claims in USN 09/925,649 in fact differ from those pending in the instant application at least the claims in USN 09/925,649 require a request for

authorization and a detection of receipt of the authorization. That is to say, claim 1 of USN 09/925,649 is as follows:

A printing method, comprising the steps of:
receiving data at a printer;
detecting a network address in the received data;
if a network address is detected, then **displaying or sending a message** notifying of the network address detection and requesting authorization to access the network address;
if **authorization to access is received**, sending on the Internet or other network an access request for a document to the network address;
retrieving the document from the network address; and
printing the document. (Emphasis added)

It is submitted that the claims in the instant application ('650) and those pending in USN 09/925,649 are different to the degree that any question of double patenting is rendered moot. For example, the independent claims of this application require a determination if a URL or external network option is enabled, the independent claims of USN 09/925,649 do not. The independent claims of USN 09/925,649 require that if a network address is detected, then a message is either displayed or sent notifying of the network address detection. These claims further require a request for authorization to access the network address to be included in this message. The independent claims of this application ('650) do not contain these latter mentioned limitations and therefore do define the same subject matter.

It is further submitted that this issue can only be effectively resolved when the claims in both applications are allowed and/or in condition for allowance and a comparison of the claims is meaningful. It is additionally pointed out that USN 09/925,649 was filed on the same day as the instant application and thus further renders both the effect and need for a terminal disclaimer, moot.

Rejections under 35 USC § 102

The rejection of claims 1-10, 17-18 and 22-26 under 35 USC §102(e) as being anticipated by Tabata et al. (USP 6,537,324), is respectfully traversed.

In this rejection, it is advanced that independent claims 1, 22 and 24-26 are anticipated by Tabata et al. In support of this position the following arguments 1) - 5) are disclosed.

- 1) It is stated that Tabata et al. discloses a printing method comprising receiving data adapted to contain a network address at a printer (470B) and column 23, lines 56-63 and column 24, lines 11-17, are cited.

This is not correct. Tabata et al. does not disclose receiving data at a printer such as printer 470B.

Column 23, lines 56-63 discloses:

Then, the medium form 420 with the mark(s) 51 added thereto is read by the scanner unit (correlated information identifying unit) 430 or 470A (S2101). In this case, each of the scanner units 430, 470A reads a code area 206 from the medium form 420 as raster information and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

Column 24, lines 11-17 discloses:

Then, each of the scanner units identifies described position information (Refer to FIG. 7 and FIG. 8) from the coordinate values of the mark 51, identifies an address (URL) of the correlated information file from the

corresponding address information, and transfers and outputs the address to a file server 440 (S2102).

As will be appreciated, there is no disclosure of the alleged printer 470B. The rejection therefore fails in that it fails to disclose where in a single reference each of the claimed elements can be found.

As advanced in the previous response, the Tabata et al. reference, at column 23, lines 10-12, discloses that a copying machine 470 comprises a scanner unit 470A as a "correlated information identifying unit" and a printer 470B as an "output unit" and that the two units are integrated into one device. However, this "integration" does not mean that the scanner is the printer or can be considered a printer. Indeed, the two units are deliberately assigned different numerals (viz., 470A and 470B) and the disclosure quoted above, makes it clear that the scanner is a scanner and not a printer.

Thus, as noted above, inasmuch as it is necessary for a single reference to disclose each and everyone of the claimed features, and the claimed requirement that a printer receive the claimed data is not disclosed as is self-evident from the passages that the Examiner is citing, the rejection cannot be deemed tenable.

It must be appreciated that it is the scanner unit that reads the medium and reads a code area 206 which is on the medium as raster information. More specifically, column 23, lines 56-63, discloses:

Then, the medium form 420 with the mark(s) 51 added thereto is **read by the scanner unit** (correlated information identifying unit) 430 or 470A (S2101). In this case, each of the **scanner units** 430, 470A **reads a code area 206 from the medium form 420 as raster information** and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

It is therefore clear that if data is "received", it is "received" by the scanner and not the printer.

The rejection, in a nutshell, is untenable in that it impermissibly relies upon the scanner to anticipate a printer receiving data which data is able to include address information.

- 2) It is alleged that Tabata et al. discloses determining whether an external network option is enabled inasmuch as this reads on transferring the address to the file server. Column 24, lines 14-17 is cited as disclosing this feature. This section of Tabata et al. discloses:

Then, **each of the scanner units** identifies described position information (Refer to FIG. 7 and FIG. 8) from the coordinate values of the mark 51, identifies an address (URL) of the correlated information file from the corresponding address information, **and transfers and outputs the address to a file server 440** (S2102).

It is submitted that determining whether an external network option is enabled or not, does not read on transferring the address to the file server. There is no such determination disclosed in Tabata et al.

It is submitted that it is untenable to rely on the act of transferring information to a server to anticipate the act of determining whether a network option is enabled or not. The determination of an operability is distinct and separate from the act of using the operability and transferring a file.

There is no disclosure that the act of transferring data to the file server 440 functions as a test to determine if it can be transferred or not. Therefore, it cannot be assumed for the sake of rejection that routine data transfer is a test to determine if the

data can be transferred or not. There is, therefore, neither anticipation nor suggestion of determining whether a URL or external network option is enabled or not.

- 3) Tabata et al. is asserted as disclosing detecting if a network address is contained in the data received. The rejection, however, omits the limitation that the data is received by the printer. The rejection cites column 23, line 56 – column 24, line 17. This disclosure is as follows:

Then, the medium form 201 with the mark(s) 51 added thereto is read by the **scanner** (reader) 60 (S1201). In this case, the **scanner** 60 reads a code area 206 from the medium form 201 as raster information and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

The network terminal equipment (retrieving unit) 70 decodes, when having received the code area 206 read by the **scanner** 60 as well as image data for the text section, the two-dimensional bar code of the code area 206 using the two-dimensional bar code decoder in the correlated information identifying section and obtains the HTML source code of the original hypertext and linkage information or the like, and then, develops the decoded HTML source code to raster information using the HTML source code developing software, extracts a difference between the developed raster information and the raster information in the read text section using the marking identifying software, obtains an image for the mark (selection information) 51 as well as a noise image (a slight displacement between the two raster information), further removes the noise image by filtering, and identifies the mark (selection information) 51. Then, the network

terminal equipment 70 identifies described position information (Refer to FIG. 7 and FIG. 8) from the coordinate values of the mark 51, and identifies an address (URL) of the correlated information file from the corresponding address information (S1202). (Emphasis added)

Thus, it is clear that it is data which is supplied to the scanner as different from the printer, which is used to identify an address (URL). The rejection is deemed untenable for at least this reason also.

- 4) It is asserted that Tabata et al. discloses sending, on the internet, an access request for a document t the network address. Column 24, lines 18 – 23 is cited disclosing this feature.

However, this section of Tabata et al. discloses:

The file server (correlated information file retrieving unit) 440 retrieves, when having received an address (URL) of the correlated information file, an appropriate correlated information file from the appropriate file device 410 according to the address (URL) of the correlated information file (S2103).

It is not seen that this discloses an "access request" and would seem more pertinent to the following step of "retrieving the document from the network address." Indeed the rejection seems to have missed addressing the "access request" completely.

- 5) Tabata et al. is asserted as disclosing retrieving the document (column 24, lined 24 -25) and printing the document (column 24, lined 36-38). These sections of Tabata et al. respectively disclose:

The file server transfers the retrieved correlated information file to a printer 460 or to a printer 470B (S2104).

and

The printer 460 or 470B outputs the received correlated information file (including the medium form information) on recording paper as a correlated information file 450 (S2106).

While this disclosure would seem relevant to the position taken in this rejection, it must be noted that there is disclosure of the printer 470B in clear and distinct contrast to the scanner which is repeatedly and improperly relied upon to the printer.

Attention is called to the fact that Tabata et al. at column 28, line 35 – column 29, line 6, discloses the following:

Then, **the scanner unit** (correlated information identifying unit) 430 identifies a file server by searching for an available file server (S2602), and determines whether the available file server is a file server 440 as a correlated information file retrieving unit or a file server 520 as a correlated information file identifying/retrieving unit (S2603).

When it is determined that the available file server is the file server (correlated information file retrieving unit) 440, the **scanner unit 430 decodes a two-dimensional bar code of the code area 206, develops the decoded HTML source code to raster information**, extracts a difference between the developed raster information and the raster information in the read text section, obtains an image for the mark (selection information) 51 as well as a noise

image (a slight displacement between the two raster information), further executes filtering thereto, and identifies the mark (selection information) 51. Then, the **scanner unit** identifies described position information, **identifies an address (URL) of the correlated information file from the corresponding address information, and transfers and outputs the address to the file server 440 (S2102).**

The **file server** (correlated information file retrieving unit) 440 **retrieves an appropriate correlated information file from the appropriate file device 410 according to the address (URL) of the correlated information file (S2103), and transfers the retrieved correlated information file to the printer 460 (S2104). However, when the correlated information file itself is found to be a hypertext, as it is required to output the correlated information file as medium form information, the **file server 440 prepares medium form information from the hypertext and transfers the medium form information to the printer 460 (S2105).****

(Emphasis added)

Thus, the only time that the printer is disclosed as receiving data is when something is to be printed. This is confirmed by the citations selected for the sake of rejection.

In order for a *prima facie* case of anticipation to be established a single reference must disclose each and every one of the claimed steps. Vague innuendo and inference cannot be used in place of clear, concise disclosure.

Thus, in summary, the Tabata et al. reference fails to disclose, in the manner necessary to establish a *prima facie* case of anticipation, that information, which is derived by scanning with the scanning unit 470A, is in fact ever received by the printer 470B. The fact that the scanning and printing units are integrated into a single copying

machine 470 does not negate the fact that they are referred to as separate devices throughout the disclosure of Tabata et al., and does not allow the presumption that, if the scanner receives or generates data, that the printer is going to receive the same. In fact, it is self-evident that the printer never receives this information. The utility of transferring information which is derived from the scanner to the printer without the printer printing is, without clear disclosure to the contrary, pointless. That is to say, in Tabata et al. the printer is intended to print and print only.

Further, the act of transferring data to a server does not at all disclose or suggest the act of inquiring as to network operability. A test to determine if a network is available neither anticipates nor renders obvious a transfer of data over a line which is fully expected to be constantly in full and reliable operation. There must be an expectation of a possible failure before "determining whether a URL or external network is enable" in the sense claimed, is disclosed/suggested.

In addition, the position that the Tabata et al. reference discloses detecting if a network address is in the data which is received at the printer, is untenable. As noted above, in Tabata et al., the only data which is supplied to the printer comes from a server and would, absent any disclosure to the contrary, have to be presumed to be simply printing instructions.

Rejections under 35 USC § 103

- 1) The rejection of claims 11-14 under 35 USC § 103(a) as being anticipated by Tabata et al. in view of Russell et al. is again traversed. This rejection falls with the fall of the anticipation rejection of claim 1. Further, the teachings of Russell et al. do not overcome the clear shortcomings which are introduced by the "interpretations" of the disclosure and how the claimed subject matter of the parent claims is inappropriately held to be anticipated.
- 2) The rejections of claims 15 and 16 and 19-21 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Wolff, are respectfully traversed on the same grounds as the rejection of claims 11-14.

Conclusion

It is submitted that this application is in condition for allowance. Favorable consideration of the newly presented claims along with those rejected in this Office Action, are respectfully requested.

Respectfully submitted,

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